

REMARKS

Prior to Applicants filing this response, claims 1, 2, 5, 6, 8, 9 and 11-24 were pending in this application, and claims 3, 4, 7 and 10 were canceled. Claims 11-24 stood withdrawn, and claims 1, 2, 5, 6, 8 and 9 remained under examination and stood rejected.

Claims 1, 5, 8, and 11-24 have been canceled herein, and claims 2, 6, and 9 remain under examination and have been amended herein. No new matter has been added.

EXAMINER INTERVIEW

Applicants wish to thank the Examiner for taking part in a telephone interview with attorneys Keith Heidmann and Charles Leeck on June 9, 2009. In the interview, possible claim cancelations and amendments to overcome the current § 112 rejections were discussed. Although no final agreement was reached, the interview served to clarify the remaining outstanding issues, and the claim cancelations and amendments presented herein are the same as the proposed claim cancelations and amendments discussed during the interview.

35 U.S.C. § 112, 2ND PARAGRAPH REJECTIONS

The Office has rejected claims 1, 5, and 8 under § 112, 2nd Paragraph, as being indefinite. Specifically, the Office asserted that the claims are not clear in that the recited compounds include both a broad genera of recited compounds and a narrower group of compounds "which specifically binds to androgen receptor." Thus, it is unclear whether the additional limitation "which specifically binds to androgen receptor" is intended to be merely descriptive of the recited compounds, or whether it defines a sub-genus of the recited compounds.

In response, without agreeing with the Office's assertion and solely to move prosecution forward, Applicants have canceled claims 1, 5, and 8. Accordingly, these rejections are now moot.

35 U.S.C. § 112, 1ST PARAGRAPH REJECTIONS

The Office has rejected claims 8 and 9 under § 112, 1st Paragraph, as not being enabled to the full scope of the claims. Specifically, the Office asserted that the specification does not reasonably provide enablement for the prevention of androgen-dependent prostate cancer in patients.

Applicants note that claim 8 has been canceled herein. In response, without agreeing with the Office's assertion and solely to move prosecution forward, Applicants have amended claim 9 to

recite reducing the recurrence of androgen-dependent prostate cancer rather than preventing its recurrence. Support for claim 9 as amended can be found in e.g. pages 22 (lines 4-9, 20-24) and 23 (line 1) of the as-filed specification. Because claim 9 now recites reducing rather than preventing the recurrence of androgen-dependent prostate cancer, the scope of enablement rejection has been overcome, and Applicants respectfully request the withdrawal of this rejection.

The Office has additionally rejected claims 1-2, 5-6, and 8-9 under § 112, 1st Paragraph as failing to comply with the written description requirement. Specifically, the Office asserted that the claims contain subject matter not described in the specification in such a way as to convey Applicants' possession of the claimed invention. In particular, the Office asserted that Applicants' recitation of compounds which "specifically binds" to the androgen receptor implies that the compounds do not bind to any other receptors or biological targets in the body of the subject, which, the Office asserts, "is clearly not the case."

Applicants note that claims 1, 5, and 8 have been canceled herein. In response, without agreeing with the Office's assertion and solely to move prosecution forward, Applicants have amended claims 2, 6, and 9 to delete the word "specifically" in front of the phrase "binds androgen receptor." Thus, the claims as amended recite that the compounds bind androgen receptor, but not specifically (or only) androgen receptor. Because the remaining claims no longer recite that the compounds "specifically" bind androgen receptors, these written description rejections have been overcome, and Applicants respectfully request the withdrawal of these rejections.

CLARIFYING AMENDMENTS

Applicants have further amended claims 2, 6, and 9 to add an "s" at the end of the term "androgen receptor" to make the term plural (androgen receptors). These amendments, which were suggested by the Examiner, are made to clarify the claims without affecting or limiting their scope in any way.

CANCELLATION OF WITHDRAWN CLAIMS

As a result of a previous restriction requirement, claims 11-24 were previously withdrawn. To help facilitate the timely prosecution of this application, Applicants have canceled these claims herein. Applicants reserve the right to pursue the canceled claims in one or more continuing applications.

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Conclusion and Fees

In light of the claim cancelations, amendments, and remarks presented herein, Applicants respectfully request that the claims rejections be withdrawn and that a Notice of Allowance be issued in the remaining claims.

This response is believed to be timely, and no fees or time extensions are believed necessary. However, if an additional extension of time is needed, consider this the required petition, and if additional fees are required, please charge any additional fees in this or any future response to Deposit Account No. 17-0055.

Respectfully submitted,
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